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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

GOLDBERG, JEANINE ANNE

ART UNIT PAPER NUMBER

1634

DATE MAILED: 01/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

DETAILED ACTION

1. The reply filed on 10/27/04; 10/1/04, 7/27/04 is not fully responsive to the prior Office Action because of the following omission(s) or matter(s).

"In an application in which prosecution on the merits is closed, i.e., after the issuance of an Ex Parte Quayle action, where an amendment is presented curing the noted formal defect and adding one or more claims some or all of which are in the opinion of the examiner not patentable, or will require a further search, the amendment in such a case will be entered only as to the formal matter. Applicant has no right to have new claims considered or entered at this point in the prosecution. The action mailed January 26, 2004, noted that while applicants requested rejoinder there were no method claims that encompassed the probe of SEQ ID NO: 126 and concluded that rejoinder was not appropriate. In the instant case, Claim 14 has been amended to be directed to an allowable claim. Claim 14 would be allowable. However, Claim 1-2, 5-13, 15-19, 24 which did not previously rely on SEQ ID NO: 126 have been amended to require SEQ ID NO: 126. Each of these claims contains new grounds of rejection that would be necessitated. Rejoinder of the newly amended claims would require further considerations, as set forth in the interview summary of January 5, 2005. In an effort to promote compact prosecution, the examiner has indicated she is willing to consider rejoinder of the amended method claims which rely on the allowed SEQ ID NO: 126, however the presence of the 112/2nd rejections preclude the examiner from rejoinder at

this time. The applicant is invited to overcome the identified 112/2nd issues and the examiner will rejoin the claims for allowance.

MPEP 821.03 provides, "In view of the rejoinder procedure, and in order to expedite prosecution, applicants are encouraged to present such process claims, preferably as dependent claims, in the application at an early stage of prosecution. Process claims which depend from or otherwise include all the limitations of the patentable product will be entered as a matter of right if the amendment is presented prior to final rejection or allowance. Amendments submitted after final rejection are governed by 37 CFR 1.116. Process claims which do not depend from or otherwise include the limitations of the patentable product will be withdrawn from consideration, via an election by original presentation (see MPEP § 821.03)."

With regard to the sequence rules, the response asserts that the sequence are describes the sequences by SEQ ID NO: throughout the specification. The response points the Table 1 and 2 as summarizing the primers and probes by SEQ ID NO:. The response asserts that all of the sequences are identified by SEQ ID NO:. This argument has been thoroughly reviewed, but is not found persuasive because the MPEP and 37 CFR 1.821(d) "requires the use of the assigned sequence identifier in all instances where the description or claims of a patent application discuss sequences regardless of whether a given sequence is also embedded in the text of the description or claims of an application. This requirement is also intended to permit references, in both the description and claims, to sequences set forth in the "Sequence Listing" by the

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use of assigned sequence identifiers without repeating the sequence in the text of the description or claims.” MPEP 1.821 further states, “Where the description or claims of a patent application discuss a sequence that is set forth in the “Sequence Listing” in accordance with paragraph (c) of this section, reference must be made to the sequence by use of the sequence identifier, preceded by “SEQ ID NO:” in the text of the description or claims, even if the sequence is also embedded in the text of the description or claims of the patent application.” As noted by the MPEP, the identifier must be used in all instances. Thus, as noted in the Quayle action, there are numerous sequences which are not identified by SEQ ID NO: identifier as required. Appropriate correction is required.

2. See 37 CFR 1.111. Since the above-mentioned reply appears to be *bona fide*, applicant is given **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Jeanine Goldberg whose telephone number is (571) 272-0743. The examiner can normally be reached Monday-Friday from 7:00 a.m. to 4:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones, can be reached on (571) 272- 0745.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status

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information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

The Central Fax Number for official correspondence is (571) 273-8300.

A handwritten signature in black ink, appearing to read "J. Goldberg".

Jeanine Goldberg

Patent Examiner

January 5, 2005